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EXAMINER

WANG, TED M

ART UNIT PAPER NUMBER

2634

DATE MAILED: 11/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/670,869

Applicant(s)

HIRAI, JUN

Examiner

Ted M Wang

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. Claims 1-21 are pending in the application.

#### *Drawings*

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **Reference elements 22-25 in Fig.2 and reference element 6 in Fig.3.** A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: **Reference elements 201-204 in Fig.2.** A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### *Specification*

4. The disclosure is objected to because of the following informalities:
  - Page 1, Description of the Related Art, line 14, the "DDS" should be changed to "DSS".
  - Page 5, lines 7-9, the "a first output step ..... processing of the generating step;" cited twice and should be deleted.

- Page 10 lines 10 and 25, and page 11 line 12, the "paper view" should be changed to "pay per view".
- Page 14, line 9, the "ATSC broadcast" should be changed to "DSS broadcast", and line 10, the "DSS broadcast" should be changed to "ATSC broadcast".

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura (PT5,844,623).

- In regard claim 1, Iwamura cited by the applicant discloses a television with integrated receiver decoder for receiving a digital satellite broadcasting signal (Fig.2 element 110, and column 3 lines 17-24) containing at least one of a first broadcast signal (Fig.2 elements 112 and 114, and column 4 lines 45-52) and a second broadcast signal (Fig.2 element 110, and column 3 lines 17-24), characterized by comprising: signal receiving means for receiving said digital

satellite broadcasting signal (Fig.2 element 110, and column 3 lines 17-24); judging means for judging whether said digital satellite broadcasting signal received by said signal receiving means is the first broadcast signal or the second broadcast signal (column 4 lines 20-27); generating means for generating an analog signal (Fig.2 elements 112 or 114, 15-23, 4, 5, 7, and 12, and column 4 line 28-36) with the first broadcast signal (Fig.2 elements 112 and 114, and column 4 lines 45-52) in accordance with the judgment result (column 4 lines 20-27) of the judging means; first output means for outputting the analog signal generated in said generating means from an analog interface (Fig.2 element 12, and column 4 line 28-36); conversion means for converting the data structure of the second broadcast signal (Fig.2 element 110, and column 3 lines 17-24) in accordance with the judgment result of said judging means to generate a third broadcast signal (column 1 lines 28-44, and column 3 lines 25-42); and second output means for outputting the third broadcast signal generated in said conversion means from a digital interface (column 1 lines 28-44, and column 3 lines 25-42).

- In regard claims 3 and 8, the limitation that the digital interface is IEEE1394 interface can further be found in Fig. 2 element 3, column 1 lines 28-44, and column 3 lines 25-42.
- In regard claim 6, which is a method claim related to claim 1. All limitation is contained in claim 1. The explanation of all the limitation is already addressed in the above paragraph.

7. Claims 14, 15, 17, 18, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (PT6,204,884).

- In regard claim 14, Lee discloses a multi-system television with a method of a first input step of inputting an analog signal which is a base band signal of a first broadcast signal (Fig. 2 elements 200, 218, 220, 222, 224, and 226-229, and column 3, lines 4-33); a second input step of inputting a digital signal which is a second broadcast signal (Fig.2 element 202, and column 3 lines 41-49); a decoding step of decoding the digital signal to generate a base band signal of the second broadcast signal (Fig.2 elements 232, and column 3 lines 50-56, and column 1 lines 26-28); a selection step of selecting one of the base band signal of the first broadcast signal input through the processing of said first input step and the base band signal of the second broadcast signal generated in the processing of said decoding step (column 3 lines 50-56, and Fig.2 element 204 and column 4 lines 5-15); and a display control step of controlling an image display corresponding to the base band signal of the first or second broadcast signal selected in the processing of said selection step (Fig.2 element 204 and column 4 lines 5-15, and column 1 line 56 – column 2 line 3).
- In regard claims 15, 18, and 21, the limitation of a signal receiving step of receiving a third broadcast signal (Fig.2 elements 202, 231, 234, and column 1 lines 47-50), wherein said decoding step also decodes the third broadcast signal to generate the base band signal of the third broadcast signal (Fig.2 elements 234, and column 3 lines 50-62).

- In regard claim 17, which is a method claim related to claim 14. All limitation is contained in claim 14. The explanation of all the limitation is already addressed in the above paragraph.
- In regard claim 20, the limitation of a display control step of controlling an image display corresponding to the base band signal of the first or second broadcast signal selected in the processing of said selecting step can further be found in Fig. 2 element 204, and column 4 lines 5-15, and column 1 line 56 – column 2 line 3. All limitation is contained in claim 14. The explanation of all the limitation is already addressed in the above paragraph.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (PT5,844,623) in view of Stapleton (6,124,893).

- In regard claims 2 and 7, Iwamura cited by the applicant discloses all limitation except specifically teaching that the second broadcast signal is an HD (High Definition) broadcast signal.

Stapleton discloses a versatile video transformation device with an ATSC HDTV signal inputs (Fig. 2 element 2, and column 11 lines 33-39) in order to make present standard television sets compatible at low cost with the latest advancements in free HD whilst allowing a multitude of other DTV programs and ancillary data to fill to a greater extent the remaining channel allocations by FCC to TV broadcasters.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Iwamura's a television with integrated receiver decoder in view of Stapleton's disclosure in order to make present standard television sets compatible at low cost with the latest advancements in free HD whilst allowing a multitude of other DTV programs and ancillary data to fill to a greater extent the remaining channel allocations by FCC to TV broadcasters.

10. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (PT6,204,884) in view of Stapleton (6,124,893).

- In regard claims 16 and 19, Lee discloses all limitation as described in claims 14 and 15 except specifically teaching that the second broadcast signal is an HD (High Definition) broadcast signal. All other limitation is contained in claims 14 and 15. The explanation of all the limitation is already addressed in the above paragraph.

Stapleton discloses a versatile video transformation device with an ATSC HDTV signal inputs (Fig. 2 element 2, and column 11 lines 33-39) in order to make present standard television sets compatible at low cost with the latest



advancements in free HD whilst allowing a multitude of other DTV programs and ancillary data to fill to a greater extent the remaining channel allocations by FCC to TV broadcasters.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lee's multi-system television in view of Stapleton's disclosure in order to make present standard television sets compatible at low cost with the latest advancements in free HD whilst allowing a multitude of other DTV programs and ancillary data to fill to a greater extent the remaining channel allocations by FCC to TV broadcasters.

11. Claims 4, 5, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (PT5,844,623) in view of Okuyama et al. (5,987,126).

- In regard claims 4, 9, and 12, Iwamura cited by the applicant discloses all limitation except specifically teaching that adds the analog signal with a signal for suppressing copy of the analog signal.

Okuyama et al. discloses a device having a digital interface and a network system with a copy protection that adds the analog signal with a signal for suppressing copy of the analog signal (Fig. 17 and column 17 line 40 – column 18 line 4) in order to specify the copy prohibition for a DVD-ROM disk.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Iwamura's multi-system television in view of Okuyama's disclosure in order to specify the copy prohibition for a DVD-ROM disk.

- In regard claims 5, 10, and 13, the limitation that an encrypting circuit is included for encrypting the third broadcast signal can further be taught by Okuyama et al. in Fig.16 element 207 and column 19 line 57 – column 20 line 6 in order to further enhance the copyright protection.
- In regard claim 11, the limitation that a recording medium recorded with a program which is readable by a computer and serves to process digital satellite broadcasting signal received can further be taught by Okuyama et al. in column 22 lines 23-30 and Fig. 30 element 113 in order to have higher quality video image recorded. All other limitation is contained in claim 1. The explanation of all the limitation is already addressed in the above paragraph.

### ***Conclusion***

12. Reference 6,317,168, 6,30,5021, 6,137,539, and 6,118,486 are cited because they are put pertinent to the Digital TV receiver and DVR. However, none of references teach detailed connection as recited in claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted M Wang whose telephone number is (703) 305-0373. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Chin can be reached on (703) 305-4714. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2634

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Ted M Wang  
Examiner  
Art Unit 2634

Ted M. Wang



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